REMARKS

This Amendment is submitted in response to the Office Action dated May 9, 2007, having a shortened statutory period set to expire August 9, 2007. In the present Amendment, Claims 22-42 are now pending.

I. Claim Rejection Under 35 U.S.C. § 112

In the present Office Action, Claims 22-42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Specifically, on page 3 of the present Office Action, regarding independent Claims 22, 29, and 36, Examiner states that it "is unclear how the communication program encapsulates the first file when the first file has not been sent and received".

Also, on page 3 of the present Office Action, regarding dependent Claims 23, 30, and 37, Examiner states that the element of "displaying said first file in said communication program" is "indefinite as to how the first file is displayed when the file has not been sent and received".

Applicants have amended independent Claims 22, 29, and 36 and dependent Claims 23, 30, and 37, to indicate that the encapsulating and displaying is performed "upon receipt of said first file by said communication program". Support of the amendments can be found in the present Specification, paragraph [0031], *et seq.* and Figure 3, reference numbers 320 and 322.

Further, on page 3 of the present Office Action, Examiner has rejected independent Claims 22, 29, and 36 as lacking sufficient antecedent basis for the element reciting "said predetermined length of time". Applicants have amended Claims 22, 29, and 36 by replacing "said" with "a".

II. Claim Rejection Under 35 U.S.C. § 103

General requirements for a claim rejection under 35 U.S.C. § 103

According to 35 U.S.C. § 103(a):

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

To make the obviousness determination, the U.S. Supreme Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) that three factors must be considered:

(1) the scope and content of the pertinent prior art;
(2) differences between the pertinent prior art and the invention at issue; and
(3) the ordinary level of skill in the pertinent art.

The U.S. Supreme Court clarified in *KSR Intern. Co. v. Teleflex, Inc., 127 S.Ct. 1727* that a non-obviousness determination must include an inquiry as to "whether the improvement is more than the predictable use of prior art elements according to their established functions." Also, the Court in *KSR* stated that:

> [I]t will be necessary for the court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having the ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

However, the Court in *KSR* emphasized that "the analysis [of non-obviousness] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative states that a person of ordinary skill in the art would employ".

A. Rejection of Claims 22-42 under 35 U.S.C. § 103(a)

In the present Office Action, Claims 22-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tormey et al.* (U.S. Pub. No. 2005/0071239 – hereinafter referred to as "*Tormey*") in view of *Nair* (U.S. Pub. No. 2004/0193900 – hereinafter referred to as "*Nair*"). After careful consideration of Examiner's rejection, Applicants assert that Claims 22-42, as now amended, are not rendered unpatentable by the combination of *Tormey* and *Nair* in view of the arguments herein.

1. Rejection of independent Claims 22, 29, and 36

a. Scope and content of the prior art

Tormey discloses utilizing a web-based search engine and receiving a listing. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 44, lines 1-2. *Tormey* also discloses allowing a user to elect the receipt of the search results via an e-mail message. *Tormey*, paragraph 83.

Nair discloses choosing a method of delivery based on a connection type. Video is sent immediate on a broadband connection or delivery is delayed and sent later by a modem connection. *Nair*, paragraph 58. The selection of the delivery method is based on the amount of time to download a file to reduce bandwidth consumption during peak hours. *Nair*, paragraph 58.

b. Differences between the prior art and the invention

Applicants have amended exemplary Claims 22 to include the elements of:

> sending a request for a first file from a communication program; and
> in response to determining a predetermined length of time from when said request is sent has expired, and upon receipt of said first file by said communication program, said communication program encapsulating said first file in a message transmission and sending said message transmission to a target address.

Support of the amendments can be found in the present Specification, paragraph [0031], *et seq.* and Figure 3, reference numbers 320 and 322. Upon further review of Examiner's references, Applicants respectfully submit that nothing in the combination of *Tormey* and *Nair* discloses or suggests "in response to determining a predetermined length of time from when said request is sent has expired, and upon receipt of said first file by said communication program, said communication program encapsulating said first file in a message transmission and sending said message transmission to a target address", as recited in exemplary Claim 22.

At most, the combination of *Tormey* and *Nair* shows a system that enables a user to perform a search on a web-based search engine while enabling a user to receive a response to the search in the form of an e-mail message. The delivery of the response would be delayed by

connection type. If the connection is a broadband connection, the delivery is made immediately. If the connection is a dial-up connection, the delivery is made during off-peak hours.

In exemplary Claim 22, the actions of the communication program are taken in response to the expiration of a predetermined length of time from when the request is sent. Once the communication program has determined that the predetermined length of time from when the request is set has expired and has received the first file, the communication program encapsulates the first file in a message transmission and send the message transmission to a target address.

c. Non-obviousness of the differences

Upon review of *Tormey* and *Nair*, nothing in the combination would suggest to a person with ordinary skill in the art to employ creative states or inferences that would lead to Applicants' invention as recited in exemplary Claim 22. The result of a combination of *Tormey* and *Nair* would be a system that enables a user to perform a search on a web-based search engine while enabling a user to receive a response to the search in the form of an e-mail response. The delivery of the response would be delayed by connection type. If the connection is a broadband connection, the delivery is made immediately. If the connection is a dial-up connection, the delivery is made during off-peak hours.

A person with ordinary skill in the art would not immediately see the connection between the expiry of the predetermined length of time from when the request is sent, the receipt of the file in the communication program and encapsulation of the file in a message transmission and send the message to a target address, once the file is received in the communication program ("in response to determining a predetermined length of time from when said request is sent has expired, and upon receipt of said first file by said communication program, said communication program encapsulating said first file in a message transmission and sending said message transmission to a target address"), as recited in exemplary Claim 22.

Therefore, in view of the aforementioned arguments, Applicants submit exemplary independent Claim 22, similar independent Claims 29 and 36, and all dependent claims are not rendered unpatentable by the combination of *Tormey* and *Nair* under 35 U.S.C. § 103(a). Applicants respectfully request that the rejection be withdrawn.

2. Rejection of dependent Claims 28, 35, and 42

a. Scope and content of the prior art

Tormey discloses utilizing a web-based search engine and receiving a listing. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 44, lines 1-2. *Tormey* also discloses allowing a user to elect the receipt of the search results via an e-mail message. *Tormey*, paragraph 83.

Nair discloses choosing a method of delivery based on a connection type. Video is sent immediate on a broadband connection or delivery is delayed and sent later by a modem connection. *Nair*, paragraph 58. The selection of the delivery method is based on the amount of time to download a file to reduce bandwidth consumption during peak hours. *Nair*, paragraph 58. *Nair* also discloses determining when to transmit data from a server to a user, depending on the type of network connection and the time of day the request is sent. *Nair*, paragraph 45.

b. Differences between the prior art and the invention

Exemplary Claims 28 recites "temporarily and dynamically adjusting said predetermined length of time, in response to determining said communication program is deselected as a foreground task running on a data processing system." Examiner cites *Nair*, paragraph 45, lines 16-20 as disclosing the recited element in exemplary Claim 28. The cited passage discloses:

> However, if the unit uses its modem connection at 460, the unit will then automatically dial into the local, proprietary connection at a later time, such as at night (or, if forced by the user, it will dial up when commanded) and pull the files from the staging server 445.

At most, the combination of *Tormey* and *Nair* shows a system that enables a user to perform a search on a web-based search engine while enabling a user to receive a response to the search in the form of an e-mail message. The delivery of the response would be delayed by connection type. If the connection is a broadband connection, the delivery is made immediately. If the connection is a dial-up connection, the delivery is made during off-peak hours.

In exemplary Claim 28, whether the communication program "temporarily and dynamically adjusts the predetermined length of time" is determined by whether the

communication program is deselected as a foreground task. In *Nair*, it appears that Examiner has attributed when the media content is delivered to a "predetermined length of time" and indicates that the "temporarily and dynamically adjusting said predetermined length of time" is shown by delaying the delivery due to factors such as connection type and media size. Nothing in the combination of *Tormey* and *Nair* discloses adjusting a predetermined length of time, in response to determining that the communication program is deselected as a foreground task ("temporarily and dynamically adjusting said predetermined length of time, in response to determining said communication program is deselected as a foreground task running on a data processing system"), as recited in exemplary Claim 28 and disclosed in the present Specification, paragraph 31.

c. Non-obviousness of the differences

Upon review of *Tormey* and *Nair*, nothing in the combination would suggest to a person with ordinary skill in the art to employ creative states or inferences that would lead to Applicants' invention as recited in exemplary Claim 28. The result of a combination of *Tormey* and *Nair* would be a system that enables a user to perform a search on a web-based search engine while enabling a user to receive a response to the search in the form of an e-mail response. The delivery of the response would be delayed by connection type. If the connection is a broadband connection, the delivery is made immediately. If the connection is a dial-up connection, the delivery is made during off-peak hours.

A person with ordinary skill in the art would not immediately see the connection between adjusting the predetermined length of time with the communication program's task status ("temporarily and dynamically adjusting said predetermined length of time, in response to determining said communication program is deselected as a foreground task running on a data processing system"), as recited in exemplary Claim 28.

Therefore, in view of the aforementioned arguments, Applicants submit exemplary dependent Claim 28 and similar dependent Claims 35 and 42 are not rendered unpatentable by the combination of *Tormey* and *Nair* under 35 U.S.C. § 103(a). Applicants respectfully request that the rejection be withdrawn. Applicants also submit that Claims 28, 35, and 42 (dependent on independent Claims 22, 29, and 36, respectively) are not unpatentable by the combination of

Tormey and *Nair* because of the dependency of Claims 28, 35, and 42 on the independent claims in view of the aforementioned arguments regarding independent Claims 22, 29, and 36.

B. Motivation to combine *Tormey* and *Nair*

Even, *arguendo*, if the combination of *Tormey* and *Nair* discloses (or suggests) each and every element of Applicants invention, Applicants also assert that Examiner has not shown sufficient motivation to combine *Tormey* and *Nair*. "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. [citations omitted] Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988).

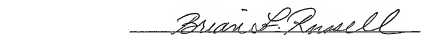
Applicants respectfully submit that a person with ordinary skill in the art would not have had the motivation to combine *Tormey* with *Nair* because *Tormey* discloses the querying of a web-based search engine and the receipt of the query results via e-mail. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 83. *Nair* on the other hand, discloses the control of the dissemination of digital works and limiting the transfer of high-bandwidth activities, such as the "video transfer between units" to off-peak hours to "reduce bandwidth consumption during peak hours". *Nair*, paragraph 58. For example, "if the user has a video file that is 10 megabytes in size, that file might take a substantial amount of time to transfer over the unit's 56k modem, tying up the user's phone line for that extended period." *Nair*, paragraph 58.

A person with ordinary skill in the art would not have had the motivation to combine a low-bandwidth activity (receiving search results from a web-based search engine) with a mechanism that defers the transfer of high-bandwidth media to off-peak hours to reduce bandwidth consumption during peak hours. Therefore, Applicants respectfully request that the rejection be withdrawn.

III. CONCLUSION

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM Corporation Deposit Account Number 09-0447**.

Respectfully submitted,



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